IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	Atty. Docket
PHILIP S. NEWTON ET AL.	PHNL030819US1
Serial No.: 10/564,296	Group Art Unit: 2621
Filed: January 10, 2006	Examiner: D.T. Tekle
	CONFIRMATION NO.: 7969

METHOD AND APPARATUS FOR RECORDING A SIGNAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

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(i) Real Party in Interest

The real party in interest in this application is KONINKLIJKE PHILIPS ELECTRONICS N.V. by virtue of an assignment from the inventors recorded on January 10, 2006, at Reel 017464, Frame 0102.

(ii) Related Appeals and Interferences

There are no other appeals and/or interferences related to this application.

(iii) Status of Claims

Claims 1-13 and 15 stand finally rejected by the Examiner; claims 14 and 16 have been cancelled.

(iv) Status of Amendments

There was one Response filed on July 15, 2010, after final rejection of the claims on May 25, 2010, this Response having been considered by the Examiner.

(v) Summary Of Claimed Subject Matter

The subject invention, as claimed in claim 1, includes: "An apparatus for recording comprising:

means for receiving ***(Fig. 2: 201; specification page 7, line 24)*** a source signal having associated first play time information ***(Fig. 1: 101; specification page 7, lines 10-21)***;

means for generating a recording signal from the source signal ***(Fig. 2: 203; specification page 7, lines 33-34, page 8, lines 9-10)***, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal ***(specification page 8, lines 10-16)***;

means for generating second time information for the recording signal in response to the first play time information and the recording discontinuity ***(Fig. 2: 209; specification page 9, lines 20-23)***; and

storage means for storing the recording signal together with the second time information ***(Fig. 2: 205; specification page 8, lines 1-2, page 9, lines 30-32)***.

As claimed in claim 2, the subject invention includes: "The apparatus for recording as claimed in claim 1, wherein the second time information comprises markers indicating events in the recording signal ***(specification page 10, lines 1-15)***."

As claimed in claim 3, the subject invention includes: "The apparatus for recording as claimed in claim 2, wherein the second time information comprises a play list comprising the markers ***(specification page 10, lines 16-18)***."

As claimed in claim 4, the subject invention includes: "The apparatus for recording as claimed in claim 1, wherein the second time information comprises event descriptors ***(specification page 11, lines 15-18)***."

As claimed in claim 5, the subject invention includes: "The apparatus for recording as claimed in claim 4, wherein the means for generating the second time information ***(Fig. 2: 209)*** is operable to generate time information of the event descriptors by modifying time information of event descriptors associated with the source signal ***(specification page 11, lines 28-32)***."

As claimed in claim 6, the subject invention includes: "The apparatus for recording as claimed in claim 5, wherein the means for generating the second time information ***(Fig. 2: 209)*** is operable to generate the time information of the event descriptors by compensating the time information of event descriptors associated with the source signal by a time gap associated with the recording discontinuity ***(specification page 12, lines 1-3)***."

As claimed in claim 7, the subject invention includes: "The apparatus for recording as claimed in claim 5, wherein time information of the event descriptors comprise relative time information associated with a play time line ***(specification page 12, lines 14-18)***."

As claimed in claim 8, the subject invention includes: "The apparatus for recording as claimed in claim 5, wherein said apparatus further comprises means for extracting the event descriptors associated with the source signal from a transport

signal comprising the source signal ***(Fig. 2: 203; specification page 12, lines 19-20)***."

As claimed in claim 9, the subject invention includes: "The apparatus for recording as claimed in claim 4, wherein the event descriptor comprises a stream event comprising information for triggering an application ***(specification page 12, lines 14-25)***."

As claimed in claim 10, the subject invention includes: "The apparatus for recording as claimed in claim 1, wherein the first play time information comprises a first play time line ***(Fig. 1: (Timeline))***; specification page 7, lines 17-19), and the means for generating the second time information (Fig. 2: 209) is operable to generate a non-continuous play time line associated with the recorded signal and having a time discontinuity corresponding to the recording discontinuity ***(specification page 6, lines 7-17)***."

As claimed in claim 11, the subject invention includes: "The apparatus for recording as claimed in claim 1, wherein the source signal and the recording signal comprise Multimedia Home Platform (MHP) data ***(specification page 7, lines 5-7)***."

12. The apparatus for recording as claimed in claim 1, wherein the source signal and the recording signal comprise Digital Video Broadcast (DVB) data ***(specification page 7, lines 5-7)***.

13. A method of recording comprising the steps of:

receiving a source signal having associated first play time information ***(Fig. 1: 101; specification page 7, lines 10-21; Fig. 2: 201; specification page 7, line 24)***;

generating a recording signal from the source signal ***(Fig. 2: 203; specification page 8, lines 9-10)***, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal ***(specification page 8, lines 10-16)***;

generating second time information for the recording signal in response to the first play time information and the recording discontinuity ***(Fig. 2: 209; specification page 9, lines 21-23)***; and

recording the recording signal together with the second time information on a storage medium ***(Fig. 2: 205; specification page 9, lines 30-32)***.

Finally, as claimed in claim 15, the subject invention includes:

"A non-transitory computer-readable storage medium having encoded thereon a computer program comprising instruction to be loaded on a processor, said instructions causing the processor to perform the method as claimed in claim 13 ***(specification page 13, lines 1-4)***."

(vi) Grounds of Rejection to be Reviewed on Appeal

(A) Whether the invention, as claimed in claims 1-13 and 15, is anticipated, under 35 U.S.C. 102(e), by U.S. Patent 6,064,380 to Swenson et al.

(vii) Arguments

(A) Whether Claims 1-13 and 15 Are

Anticipated By Swenson et al.

35 U.S.C. 102(e) states:

"A person shall be entitled to a patent unless –
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(e) the invention was described in – (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or
*****"

(1) Claims 1 and 13

The Swenson et al. patent discloses bookmark for multi-media content, in which an apparatus arranged to playback a multi-media file, stores the position at which the playing back of the file was stopped thereby enabling a user to return to the stopped position when desired.

As noted in MPEP §2131, it is well founded that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "The identical invention must be shown in as

complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As noted above, claim 1 claims "An apparatus for recording comprising:

means for receiving a source signal having associated first play time information;

means for generating a recording signal from the source signal, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal;

means for generating second time information for the recording signal in response to the first play time information and the recording discontinuity; and

storage means for storing the recording signal together with the second time information."

The Examiner has indicated that Swenson et al. discloses all of the limitations in independent claims 1 and 13, as well as in the dependent claims. In particular, the Examiner states "Swenson et al. discloses an apparatus for recording comprising: means for receiving a source signal having associated first play time information; means for generating a recording signal from the source signal (column 1 lines 65-67 and column 5 lines 44-51)".

Appellants submit that the Examiner is mistaken. In particular, Swenson et al., at col. 1, line 56-67, states:

> "In modern networks, the availability and use of multimedia files is increasing. Multimedia files

include, inter alia, audio files and video files. Typically, a user may select or "click-on" a graphic or hypertext area on a selection screen to have the selected audio or video file presented at the user terminal by a player device. The present example will demonstrate the disclosed methodology relative to a video file although it is understood that corresponding methodology also applies to audio and other multimedia file presentations. Multimedia files are of varying length and may require from seconds to hours or longer to play through to the end of the file."

It should be apparent from the above that Swenson et al., at lines 65-67 (last 3 lines above), is merely describing the characteristics of multimedia files. However, when the opening portion of the paragraph is read, it should be clear that Swenson et al. is describing the selection, downloading and playing of a multimedia file. Further, there is no disclosure or suggestion that the source signal has "associated first play time information".

Further, Swenson et al., at col. 5, lines 44-51, states:

"Next, the position of the multimedia file at which the presentation was terminated is determined 421 and that position is saved in persistent memory or storage 425. The position may be determined in terms of byte position or time position or other criterion, but in any case, the position indicia stored will be sufficient to efficiently return to the position within the multimedia file at which the play was terminated."

This portion of Swenson et al. describes the storing of a position indicator indicating the position in the multimedia file that presentation (playback) was terminated. However, there is no disclosure or suggestion of generating a recording signal from the source signal.

The Examiner further indicates that Swenson et al. discloses "the recording signal comprising at least a portion of the source

signal including a recording discontinuity with respect to the source signal (column 1 lines 65-67 and column 4 lines 62-67)".

Again, Appellants submit that the Examiner is mistaken. In particular, Swenson et al., at col. 4, lines 62-67, states:

> "If a user clicks on the "Stop Without Saving" selection, any video or multimedia file being played will be stopped and the program will not save the position at which the file was stopped. However, if a user click on the "Stop & Save Position" button, the file being played will be stopped and the position at which the file was stopped will be saved to..."

This portion of Swenson et al. describes whether or not the position indicator is saved. However, there is no disclosure or suggestion of generating a recording signal, and the recording signal "comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal". It should be noted that a "recording discontinuity" is described in the subject specification on page 8, lines 9-16. Based on this description, a "recording discontinuity" is more than the mere ceasing of playback of a multimedia file.

Furthermore, the Examiner indicates that Swenson et al. discloses "means for generating second time information for the recording signal in response to the first play time information and the recording discontinuity (column 4 line 62 to column 5 line 22)."

This portion of Swenson et al. states:

> "If a user clicks on the "Stop Without Saving" selection, any video or multimedia file being played will be stopped and the program will not save the position at which the file was stopped. However, if a user click on the "Stop & Save Position" button, the file being played will be stopped and the position at

> which the file was stopped will be saved to persistent memory such the user's disk drive or in a data file associated with the user's browser program and stored on the user's hard drive. The position at which the multimedia presentation was terminated may also be transferred to the server or other persistent memory location for storage in persistent memory associated with the multimedia file or with other user data. A user may also selectively designate a custom name for the saved file by inputting in the "Title To Save" input area on the display screen. In any case, the position in the multimedia file at which the presentation was stopped represents the position at which a subsequent request to play the particular multimedia file will be initiated. The subsequent start position may also include a rewind of a predetermined or selectable length from the previously terminated position in order to refresh the user with the latter portion of the previously viewed video or other multimedia file. The saved "Title", along with other and previously saved files and file segments, may be listed in the "Multimedia Files" section of the screen display as in a typical "bookmark" function. A user may select one of the multimedia files from the "Multimedia Files" screen area to initiate the playing of the selected multimedia file from the previously saved position at which the file was last terminated."

This portion of Swenson et al. describes the position indicator to be stored, and that the position indicator may indicate the exact position at which the multimedia file was previously stopped, or may alternatively indicate a position rewound a predetermined amount of time from the actual stopped position of the multimedia file. However, there is no disclosure or suggestion that this position indicator is generated "in response to the first play time information and the recording discontinuity".

Finally, the Examiner indicates that Swenson et al. discloses "storage means for storing the recording signal together with the second time information (column 4 line 62 to column 5 lines 22).

Appellants submit there is no disclosure or suggestion in Swenson et al. for storing the recording signal along with the second time information. Rather, merely states that the position information may be stored locally (at the user's site), or alternatively, may be stored at the server where the original multimedia file is stored. However, there is no disclosure or suggestion of storing a recording signal with the second time information.

In the subject invention, as described in the specification on page 7, line 28, to page 8, line 18, the recording controller 203 receives the source signal and generates a recording signal for storage in the storage medium 205. This recording signal comprises at least a portion of the source signal including a recording discontinuity with respect to the source signal, and is recorded along with the second time information on the storage medium 205

Appellants therefore submit that there is no disclosure or suggestion in Swenson et al. of "means for generating a recording signal from the source signal, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal".

(2) Claims 2-3

Claims 2 and 3 include the limitations "wherein the second time information comprises markers indicating events in the recording signal" and "wherein the second time information comprises a play list comprising the markers".

The Examiner offers no explanation for the rejection, but merely quotes the claims and indicates the same section of Swenson et al., to wit, Col. 4, line 62 to col. 5, line 25, reproduced above.

Appellants submit that the noted section of Swenson et al. states that the position at which the multimedia file was stopped during its playback is saved, along with the entirety of the multimedia file, and that when the user decides to continue watching (or listening to) the multimedia file, the stop position is recalled and the multimedia file is played starting from the stop position (or alternatively, a position a selected period of time prior to the stop position). Swenson et al. further notes that the stop position indication, along with the multimedia file may be stored along with other multimedia files and their respective stop position indications, and listed in a "Multimedia Files" section of the display for selection by the user.

While Swenson et al. arguably describes useful features of its system, there is no disclosure or suggestion of the limitations of claims 2 and 3. Appellants note that as per *Richardson v. Suzuki Motor Co.*, "The identical invention must be shown in as complete detail as is contained in the ... claim." In this case, the noted section of Swenson et al. neither discloses nor suggests "wherein the second time information comprises markers indicating events in the recording signal" and "wherein the second time information comprises a play list comprising the markers".

(3) Claims 4, 5, 8

Claim 4 includes the limitation "wherein the second time information comprises event descriptors".

Again, the Examiner merely quotes claim 4 and indicates the same section of Swenson et al., column 4 line 62 to column 5 line 24.

"event descriptors" are described in the specification on page 11, lines 15-18, "These event descriptors identify an event and have an associated time indication. The event descriptors are generated by the time processor 209 such that the time indication relates to the NPT of the recorded signal."

In Swenson et al., the position indication merely indicates a position in the multimedia file at which the user stopped playback. While the user may also elect to save a custom Title for the file containing the multimedia file and the position indication, this does not indicate that the position indication contains anything more than the position in the multimedia file at which the user stopped playback. There is nothing in Swenson et al. relating to event descriptors, and that these event descriptors should be included in the second time information.

Claim 5 includes the limitation "wherein the means for generating the second time information is operable to generate time information of the event descriptors by modifying time information of event descriptors associated with the source signal."

Again, the Examiner merely quotes claim 5 and indicates the same section of Swenson et al., column 4 line 62 to column 5 line 24.

However, Appellants submit that there is no disclosure of event descriptors in Swenson et al., nor that the source signal has event descriptors, and that the time information of the event descriptors in the second time information is generated by modifying the time information of the event descriptors associated with the source signal.

Claim 8 includes the limitation "wherein said apparatus further comprises means for extracting the event descriptors associated with the source signal from a transport signal comprising the source signal."

Again, the Examiner merely quotes claim 8 and indicates the same section of Swenson et al., column 4 line 62 to column 5 line 24.

Appellants submit that nowhere in Swenson et al. is there any disclosure of means for extracting anything from the source signal, and that the indicated section of Swenson et al. neither discloses nor suggests means for extracting the event descriptors associated with the source signal.

Based on the above arguments, Appellants believe that the subject invention is neither anticipated nor rendered obvious by the prior art and is patentable thereover. Therefore, Appellants respectfully request that this Board reverse the decision of the Examiner and allow this application to pass on to issue.

Respectfully submitted,

by /Edward W. Goodman/
Edward W. Goodman, Reg. 28,613
Attorney

(viii) Claims Appendix

1. An apparatus for recording comprising:

means for receiving a source signal having associated first play time information;

means for generating a recording signal from the source signal, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal;

means for generating second time information for the recording signal in response to the first play time information and the recording discontinuity; and

storage means for storing the recording signal together with the second time information.

2. The apparatus for recording as claimed in claim 1, wherein the second time information comprises markers indicating events in the recording signal.

3. The apparatus for recording as claimed in claim 2, wherein the second time information comprises a play list comprising the markers.

4. The apparatus for recording as claimed in claim 1, wherein the second time information comprises event descriptors.

5. The apparatus for recording as claimed in claim 4, wherein the means for generating the second time information is operable to generate time information of the event descriptors by modifying time information of event descriptors associated with the source signal.

6. The apparatus for recording as claimed in claim 5, wherein the means for generating the second time information is operable to generate the time information of the event descriptors by compensating the time information of event descriptors associated with the source signal by a time gap associated with the recording discontinuity.

7. The apparatus for recording as claimed in claim 5, wherein time information of the event descriptors comprise relative time information associated with a play time line.

8. The apparatus for recording as claimed in claim 5, wherein said apparatus further comprises means for extracting the event descriptors associated with the source signal from a transport signal comprising the source signal.

9. The apparatus for recording as claimed in claim 4, wherein the event descriptor comprises a stream event comprising information for triggering an application.

10. The apparatus for recording as claimed in claim 1, wherein the first play time information comprises a first play time line, and the means for generating the second time information is operable to generate a non-continuous play time line associated with the recorded signal and having a time discontinuity corresponding to the recording discontinuity.

11. The apparatus for recording as claimed in claim 1, wherein the source signal and the recording signal comprise Multimedia Home Platform (MHP) data.

12. The apparatus for recording as claimed in claim 1, wherein the source signal and the recording signal comprise Digital Video Broadcast (DVB) data.

13. A method of recording comprising the steps of:

receiving a source signal having associated first play time information;

generating a recording signal from the source signal, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal;

generating second time information for the recording signal in response to the first play time information and the recording discontinuity; and

recording the recording signal together with the second time information on a storage medium.

15. A non-transitory computer-readable storage medium having encoded thereon a computer program comprising instruction to be loaded on a processor, said instructions causing the processor to perform the method as claimed in claim 13.

(ix) Evidence Appendix

There is no evidence which had been submitted under 37 C.F.R. 1.130, 1.131 or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this Appeal.

(x) Related Proceedings Appendix

Since there were no proceedings identified in section (ii) herein, there are no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. 41.37.